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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/740,568 | <b>Applicant(s)</b><br>DEWOLF ET AL. |  |
|                              | <b>Examiner</b><br>JAGDISH PATEL     | <b>Art Unit</b><br>3693              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1-5,7-9,13,14,17-19,21,22,24,25,27-29,31-33,35,37,38,42,43,46-48,50-52,54-61,64-71,74,76-79,81-86,89 and 90.

Continuation of Disposition of Claims: Claims rejected are 1-5,7-9,13,14,17-19,21,22,24,25,27-29,31-33,35,37,38,42,43,46-48,50-52,54-61,64-71,74,76-79,81-86,89 and 90.

### DETAILED ACTION

1. This communication is in response to amendment filed 6/27/07.

#### *Response to Amendment*

2. Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-52, 54-61, 64-71, 74, 76-79, 81-86 and 89-90 are currently pending. The examiner acknowledges that claim 90 was not examined due to his oversight and regrets this error. Accordingly, this office action is issued as a non-final action and covers claim 90 examination.

#### *Response to Arguments/Remarks*

3. Unexamined Claim: See previous comment.
4. Claim Rejection under 35 USC §112: see *Claim Rejections - 35 USC § 112*.
5. Claim Rejection under 35 USC §101: under the requirement of “useful concrete, and tangible” requirement withdrawn.
6. Rejection of claims 52-54, 71-74, 79, 81-84 as being non-functional has been withdrawn.
7. Applicant’s arguments with respect to rejection of claims under 35 USC 103 have been fully considered but are not persuasive. Accordingly, the rejection under 35 §USC 103 has been maintained. Detailed explanation is provided below.

The applicant’s arguments are based upon the assertions that

(a) invention disclosed by Abraham is very different from the inventions recited in claims 1, 52 and 55 because the applicant’s invention(s) concern assets such as real estate, automobiles, consumer goods etc. i.e. anything that can be owned, and for which ownership rights can be transferred. the applicant’s (claimed) invention.

(b) the applicant’s invention is directed to management of asset vs. Abraham’s concept of project management and that the subject matter involved in the claims (assets) is different from the projects (industrial process) to which Abraham patent is directed.

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(c) the interested entities in Abraham have different roles than in the applicant's claimed inventions because the data elements of an industrial project database do not signify ownership of the assets as in the applicant's inventions. In particular as emphasized by the applicant Abraham is concerned with management of security and access of data elements pertaining to different subject matter in different environment than the applicants.

The examiner agrees with these assertions of the applicants, however, they are not relevant to the patentability of the instant claims because these features do not make any contribution to the *claimed* inventions. In other words, the features enumerated by the applicant do not add anything to the claimed structure of acts and therefore do not serve as limitations on the claims. For example, language directed to an intended use of dispensing popcorn in a claim for product claim did not result in a structural or functional difference with respect to the prior art and were not held to serve as a limitation on the claim. See *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Language that is not limiting can be an issue in a claim that recites "descriptive material". As stated in MPEP 2106:

"If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV. B.1(b). *Functional* descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In *re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). *Nonfunctional* descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In *re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is

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not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).” (emphasis added)

In reference to claim 1, preamble the whereby statement “whereby a record of ownership of an asset is created and managed” only recites intended use of the method which comprises the steps recited in the body of claim because none of the method steps recite any aspect of the ownership of the asset or the asset itself. For example, the limitation “asset” is recited in the process steps assigning identifier, recording information, categorizing the information, managing read and write privileges and providing access as “non-functional” limitation which is also treated as a description of a data element. In other words the term “asset” is treated as a nonfunctional descriptive material because the functional steps do not dependent upon type of data (whether the data is pertains to an asset of the instant claim or a project of Abraham reference). Therefore, it is asserted that the process of the claimed invention differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. (MPEP 2106).

### ***Claim Rejections - 35 USC § 101***

8. Claims 71 and 74 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 71 and 74 are product claims directed to “an electronic asset record” resulting from method of claim 1. An electronic record is interpreted as nonfunctional descriptive material. The applicant states that the record is on computer readable media, and “it is clear that record is functional and can function with a computer to affect a practical result”. The examiner

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disagrees with this interpretation because, the electronic record, generated from a process of claim 1 is not computer executable code but mere collection of data which is nonfunctional descriptive material, which even if recorded on a computer readable medium remains nonfunctional (i.e. not capable of producing concrete, tangible and useful result). See MPEP § 2106 (IV)(B)(1). Claim 71 recites “allowing said processor to read write access privileges” which is treated as intended use of the asset record. Such limitation is not afforded any patentable weight. See MPEP 2111.04.

### ***Claim Rejections - 35 USC § 112***

9. Claim 54, 84 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 55-61 and 86 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: structural relationship among the means for recording, means for categorizing, means for managing and means for providing access.

Note that the “wherein” phrase of claim 55 is not further limiting the structure of the system and therefore not given any patentable weight.

Claim 84 depends on claim 52 which recites a system having electronic asset registry, an electronic interfaces as it's structural limitations. However, none of these structural limitations functionally relate to the electronic asset record of claim 84. As such the electronic asset record

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stored on a computer readable medium is a product by itself and therefore is not a functional element and cannot functionally interact with the system of claim 52 . Therefore, claim 84 combines an apparatus with a product which also renders the claim unclear and therefore indefinite.

### ***Claim Objections***

11. Claims 71, 84 and 85 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

12. The test applied for a proper dependent claim is whether the dependent claim includes every limitations of the parent claim. In this instance, Claim 84 is directed to an asset record (a product), while claim 52 is directed to an apparatus or a system. Claim 84 does not contain each and every elements of the system recited in claim 52. A product can infringe on the "asset record" of claim 84 without infringing the apparatus used to create it, namely the system of claim 52.

13. The test for proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.

14. dependent claims 71 and 74 are product claims (asset record) and analyzed as per claim 84 as being improper dependent claim.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-52, 54-, 64-70, 74, 76-79 and 81-85, 87, 88 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abraham et al. (US 5,446,903) (hereafter "Abraham").

Claim 1: Abraham teaches a method for recording information related to assets (col. 2 L 5-25), the method comprising:

identifying the asset to be entered into an asset registry;  
assigning a unique identifier to the asset;

(independent projects, inherently each project is identified by unique identifier, for the purpose of various management objectives such as tracking progress of the projects, personnel assignment, cost allocation etc.)

recording the information related to the asset in the asset  
registry, wherein the information is associated with the unique identifier;

(refer to col. 10 L 18-39, information related to a project is recorded as "predetermined groups of data elements also referred to as "data categories")

categorizing the information related the asset into multiple attributes;

(refer to "data categories" as discussed above)

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managing read and write privileges to the asset registry  
for various entities;

(col. 10 L 61- col. 11 L 17, ..“ the access which is granted may be read only or read/write access, and the access which is denied may also be write access or read/write access.)

providing access the attributes to the various entities that have an interest in the asset,  
wherein an entity having write privileges for a first attribute of the asset can write  
data related to a change in the first attribute of the asset the asset registry, and an entity having  
read privileges for a second attribute of asset can read data related to the second attribute.

((col. 10 L 61- col. 11 L 17, ..“ the access which is granted may be read only or  
read/write access, and the access which is denied may also be write access or read/write access.)

Abraham does not expressly show the assigning, recording, categorizing, managing and  
providing access pertain to assets per se in the database.

However these differences are only found in the nonfunctional descriptive material (asset  
versus project) and are not functionally involved in the steps recited. In other words the process  
of assigning, recording, categorizing, managing and providing access would be performed the  
same regardless of the type of data. Furthermore, there is no manipulative difference in the  
process involved based upon where the information is recorded, categorized or managed.

The examiner need not give patentable weight to descriptive material absent a new and  
non-obvious functional relationship between the descriptive material and the substrate. See In re  
Lowry, 32 F.3d 1579, 32 USPQ2d 1034 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70  
U.S.P.Q.2d (BNA) 1862 (Fed. Cir. May 13, 2004).

Claim 1 recites the terms “asset”, “asset registry” and “electronic asset registry” are  
treated as nonfunctional descriptive material because they do not functionally relate to the  
substrate of functional process steps of the claim. As an example, the recording step is not done

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any differently because it pertains an asset than for example it would be done for another type of information (or data) such as a project.

The descriptive material referenced above is non-functional and is not given patentable weight because there is no non-obvious functional relationship between the descriptive material and the manipulative step of recording, categorizing, managing read and write privileges and providing access. When a prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but prior art describes different descriptive material than the claim, then the descriptive material is non-functional.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the requisite process steps described in Abraham to any type nonfunctional data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 2-5, 7-9, 13-14, 17-19, 21, 25, 27, 28, 29, 31-35, 37-38, 42-43, 47-48 and 50-51, 64-70, 76-79, 81-83 :

Claim 2-3: The method of claim 1, wherein the information being recorded for an entire life cycle of the asset, portion of a life cycle of the asset, the asset (project) includes multiple components (see col. 6 L 1+ “progresses through series of steps” etc. which implies life cycle of a project (or asset).).

Claims 50-51: refer to claims 2-3 and following analysis of claims 4-5.

Claims 4-5, 7-9, 13,14,17,18,19, 21, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 64, 65-70: features recited in the aforementioned subject claims are rendered obvious as per (“non-functional limitation”) analysis of claim 1. For example, limitation of the dependent claims merely describe the asset (see as an example, claims 4-5, 7-9, 13,14,17,18,19 and 21) or entities who can access the asset registry. Such description of the asset or entities do not alter or further limit the functional process of the independent claim 1.

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For example, claim 9 recites: wherein the information related to the asset

includes data identifying a manufacturer of the asset. As noted in claim analysis the process steps must be dependent upon the descriptive limitation “asset”. However, none of the process steps are altered based upon the specifics of the asset. The manipulative steps assigning, recoding, categorizing, managing and providing access are not altered whether the assets include certain type of data such as that recited in claim 9.

Claims 76-77 are analyzed as per claims 46 and 78. (see following paragraph).

Claims 46 and 78: These claims depend upon a method (or process) claim 52. However, they do not further limit any process step of the system claim 1. For example, the step of providing access to attributes is not dependent upon the identities or type of entities accessing the attributes. Accordingly it is asserted Abraham is capable of providing access to any individual or entities since the providing access is not dependent upon the nature or type of the entities.

As per claims 52: Abraham discloses a system for recording information related to asset and providing access to the information to interested parties throughout cycle of the asset as per discussion of claim 1 and dependent claims.

Claims 56-61 do not alter the structure of the system recited in claim. Each of the claims recites the type of information recorded by the means for recording. This limitations therefore recite “intended use” of the means for recording. The system of Abraham is capable of recording any type of information including that described in the claims and therefore, Abraham meets these claim limitations.

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Claim 55. As per corresponding method claim 1, Abraham discloses a system for recording information related to an asset and providing access to the information to interested entities.

(refer to claim 1 analysis)

Claim 56. The system claim 55, wherein the means for recoding information records information related to any change status of the asset. (see col. 6 L 61- col. 7 L 35)

Claim 57. The system of claim 55, wherein the means for recording information records information related to transactions that have an affect on the asset.

(see col. 6 L 61- col. 7 L 35)

Claim 58. The system of claim 57, wherein the means for recording information records documents related to the transactions.

(see col. 6 L 61- col. 7 L 35, col. 8 L 51+ engineering change control management system )

Claim 59. The system of claim 57, wherein the means for recording information records entities participating in the transactions.

(see col. 7 L 15-35, each user of the system associated with one or more security groups..security category)

Claim 60. The system of claim 55, wherein the means recoding information records information related to the entities having interest in the asset.

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(see col. 7 L 15-35, each user of the system associated with one or more security groups..security category)

Claim 61. wherein the means for providing access to the various attributes of the asset includes means for authenticating the entity desiring access.

Claims 79, 81-83: These claims depend upon a system (or apparatus) claim 52. However, they do not further limit any element of the system claim 52. For example, the plurality of entities identified in claims do not alter the structure of the electronic interface. Accordingly it is asserted that the electronic interface of Abraham (see Figure, 1, I/O interface) meets these limitations.

(see col. 7 L 15-35 each security group is given access (read/write, read only or one)..)

Claim 86: as interpreted by the examiner that the claim recites that the means recited in claim 55 are store in a computer readable memories. Since Abraham is computerized system, it explicitly teaches that the means as enumerated are stored in the computer readable memory executed by the at lease one processor (see Hardware environment col. 7 and 8).

Claim 89: all limitations of claim 89 have been analyzed as per respective method steps in claim 1.

Claim 90: wherein said first entity writes data pertaining to the first attribute and said second entity reads data pertaining to said second attribute (refer to col. 3 L 46-53, “display only” = read, “update= write”)

17. Claims 22, 24, 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abraham as analyzed in claim 52 and further in view of Purcell (US Pat. 6081789).

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Regarding claims 22, 24 and 54,: Abraham fails to explicitly teach that the electronic interfaces is accessed via an electronic network.

However, Purcell in the same field of endeavor, teaches asset management where electronic interfaces to asset management database is accessed via an electronic network. (see col. 4 L 52-62)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the electronic interfaces accessed via an electronic network (such as the Internet) so as make the system continuously available to the interested parties.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

9/27/07